

REMARKS

1. Specification Objection - Abstract

The Examiner objected to the length and phraseology of the Abstract. The Abstract has been shortened and amended to comply with the Examiner's requests. Applicants respectfully submit that the objections to the Abstract have been overcome.

2. Specification Objection - Title

The Examiner objected to the title as not descriptive. The Examiner has suggested the title, "Gaming Machine That Automatically Prepares Tax Forms For Winnings." Respectfully, Applicants note that this suggested title is not descriptive, but rather is both extremely narrow and not on point with the focus on the claimed invention. This is particularly evident in the emphasized language from paragraphs 0007 and 0017, which has been reprinted below from the Examiner's conveyance

[0007] *However, the problem is not limited to interruptions in play due to tax regulations, or to high roller machines. Indeed, even a machine which accepts small coins, such as nickels, may have a threshold amount, any jackpot over which will cause the machine to lock up. Such thresholds may be related to limitations on the number of coins the establishment wishes to pay out at one time, or the capacity of the machine. Similar thresholds may be encountered while participating in card games or roulette games as well.*

[0017] *It should be understood that the terms "uninterrupted session", "uninterrupted play", "uninterrupted mode" and the like may include some minor delays in play, as described herein. It should further be understood that the method is presently contemplated to be used to avoid interruptions caused by jackpots in excess of various threshold amounts. Because it is currently contemplated that the most commonly encountered threshold amounts may be those imposed by taxing authorities for reporting purposes, the invention is described in terms relating thereto.*

Accordingly, if the Examiner still feels that an amended title is required, Applicants propose, "Method And Apparatus For Reducing Interruptions In Game Play Caused By Jackpots In Excess Of Various Threshold Amounts." Applicants respectfully submit that the objection to the title has been overcome.

3. Specification Objection - Drawings

The Examiner objected to the drawings as not showing every feature of the invention specified in the claims. In response, FIG. 1A has been added with appropriate reference in the specification. FIG. 1A shows inserting the agent card, selecting uninterrupted play from the menu, and inserting the player card. Additionally, claims 48-50 have been canceled. No new matter has been added. Applicants respectfully submit that the objections to the drawings have been overcome.

4. Claims Rejections - 35 U.S.C. §102(b) – Claims 1, 2, and 4-10

Claims 1, 2, and 4-10 were rejected in the Office Action dated May 12, 2003, under 35 U.S.C. §102(b) as being anticipated by Bell et al. (U.S. Patent No. 5,505,461). Applicants respectfully traverse this rejection. However, in order to provide clarification only, claims 1, 2, 4-7, 9, and 10 have been amended. Claim 1 is an independent claim. Claims 2, 4-7, 9, and 10 depend from independent claim 1. For brevity, only the bases for the rejection of the independent claim 1 is traversed in detail on the understanding that the dependent claims are also patentably distinct over the prior art as they depend directly from independent claim 1. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate, and independent bases for patentability.

The Examiner states that the Bell patent anticipates the invention of claims 1, 2, and 4-10 (i.e., includes each and every element of claims 1, 2, and 4-10). However, the Bell patent discloses (1) a gaming machine that (2) accepts a bet from a player, (3) provides a payout in response to a winning bet, (4) *stores as a credit the amount of payout over a payout threshold*, and (5) *prevents the payout of said credit*. Respectfully, it appears that the Examiner has not fully appreciated the nature of the claimed invention. In contrast to the Bell gaming machine, the claimed invention of the present application discloses a tracking device with a central server (not a gaming machine). The tracking device is configured to communicate with one or more gaming machines, store player-related information, and record jackpot related information whenever a jackpot over a threshold amount is won. In this manner, the claimed invention facilitates substantially uninterrupted gaming because it records the required jackpot information that is then later used to generate a statement

(including, but not limited to an IRS statement) with the required player and jackpot information, *after* the gaming session has been completed.

The Bell patent, by preventing the payout of winnings that have been accumulated over a payout threshold, attempts to enforce a modified taxation of these “over threshold winnings” accumulated during a gaming session by preventing uncontrolled access to these winnings (rather than simply generate a reporting statement of these winnings). This is not only a different purpose and result than that of the claimed invention, it is actually an *incompatible* purpose and result than the claimed invention of the present application, which seeks to provide substantially uninterrupted gaming. The Bell gaming machine, by preventing the payout of winning accumulated over a payout threshold, *will most likely cause an interruption in the gaming session*, which is exactly what the claimed invention prevents.

In conclusion, the Bell patent does not teach or suggest each and every element of the claimed invention, and is in fact incongruous with the claimed invention. Indeed the Bell patent, while dealing with related issues, discloses a system that is directly at odds with the claimed invention, and thus, actually teaches away from the claimed invention. Accordingly, Applicants respectfully submit that the 35 U.S.C. § 102(b) rejection of claims 1, 2, and 4-10 as unpatentable over Bell has been overcome.

5. Claims Rejections - 35 U.S.C. §102(e) – Claims 11-19, 22-25, 27-33, 35-44, and 47

Claims 11-19, 22-25, 27-33, 35-44, and 47 were rejected in the Office Action dated May 12, 2003, under 35 U.S.C. § 102(e) as being anticipated by Acres (U.S. Patent No. 6,312,333). Applicants respectfully traverse this rejection. However, in order to provide clarification only, claims 11, 14-17, 19, 23-25, 27-33, 36, 40-42, and 44 have been amended. Claims 11, 23, 24, 29, and 36 are independent claims. Claims 14-17, and 19 depend from independent claim 11; claims 25 and 27-28 depend from independent claim 24; claims 30-33 depend from independent claim 29; and claims 40-42 and 44 depend from independent claim 36. The bases for the rejection of the independent claims are traversed in detail on the understanding that dependent claims are also patentably distinct over the prior art as they depend directly from

their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate, and independent bases for patentability.

Applicants initially note that the Acres patent is somewhat similar to the Bell patent; however, the Acres patent is even farther away from the claimed invention of the present application than the Bell patent. The Examiner states that the Acres patent anticipates the invention of claims 11-19, 22-25, 27-33, 35-44, and 47, (i.e., includes each and every element of claims 11-19, 22-25, 27-33, 35-44, and 47). However, the Acres patent discloses (1) a gaming machine that (2) accepts a bet from a player, (3) provides a payout in response to a winning bet, (4) intentionally locks-up the gaming machine if the payout is over a pre-established threshold, (5) *performs a calculation based upon the amount of payout over the pre-established threshold*, (6) *actually reduces the amount of the payout over the threshold*, and (6) unlocks the gaming machine after the reduced payout has been authorized.

Again, respectfully, it appears that the Examiner has not fully appreciated the nature and function of the claimed invention. In contrast to the Acres gaming machine, the claimed invention discloses a tracking device with a central server (not a gaming machine). The tracking device is configured to communicate with one or more gaming machines, store player-related information, and record jackpot related information whenever a jackpot over a threshold amount is won. In this manner, the claimed invention facilitates substantially uninterrupted gaming because it records the required jackpot information that is then later used to generate a statement (including, but not limited to an IRS statement) with the required player and jackpot information, *after* the gaming session has been completed.

The Acres patent intentionally interrupts the gaming session, which is exactly what the claimed invention prevents. The Acres patent prevents the payout of winnings accumulated over a payout threshold because the Acres patent is specifically designed to actually enforce a true taxation of these “over threshold winnings” accumulated during a gaming session (rather than simply generate a reporting statement). This is not only a different purpose and result than that of the claimed invention of the present application; it is actually an *incompatible* purpose and result than

the claimed invention, which seeks to provide substantially uninterrupted gaming. The Acres gaming machine, by preventing the payout of winning accumulated over a payout threshold, *absolutely causes an interruption in the gaming session*, which is exactly what the claimed invention prevents. The Acres gaming machine then reduces the accumulated winnings of the player over the threshold amount. This is an action that many patrons may find highly objectionable and annoying.

In conclusion, the Acres patent does not teach or suggest each and every element of the claimed invention, and is in fact incongruous with the claimed invention. Acres patent discloses a system that is directly at odds with the claimed invention, and accordingly, actually teaches away from the claimed invention. Accordingly, Applicants respectfully submit that the 35 U.S.C. § 102(e) rejection of claims 11-19, 22-25, 27-33, 35-44, and 47 as unpatentable over Acres has been overcome.

6. Claims Rejections - 35 U.S.C. §103(a) – Claim 3

Claim 3 was rejected in the Office Action dated May 12, 2003, under 35 U.S.C. § 103(a) as being unpatentable in view of Bell et al., and further in view of Bergeron et al. (U.S. Patent No. 4,882,473) and Pease et al. (U.S. Patent No. 5,326,104). Applicants respectfully traverse this rejection. However, in order to provide clarification only, claims 1 and 3 have been amended. Claim 1 is an independent claim. Claim 3 depends from independent claim 1. For brevity, only the bases for the rejection of the independent claim 1 are traversed in detail on the understanding that dependent claim 3 is also patentably distinct over the prior art as it depends directly from independent claim 1. Nevertheless, the dependent claim 3 includes additional features that, in combination with those of independent claim 1, provide further, separate, and independent bases for patentability.

The Examiner states that the Bell patent teaches the invention substantially as claimed, but does not teach inserting an agent card or selecting uninterrupted play from a menu. The Examiner further states that Bergeron teaches insertion of an agent card for the purpose of enhancing security, and that Pease teaches a menu-driven system. The shortcomings of the Bell patent are well

documented in Section 4 above. Neither the Bergeron patent nor the Pease patent satisfy these shortcomings.

The claimed invention discloses a *tracking device with a central server* (not a gaming machine). The tracking device is configured to communicate with one or more gaming machines, store player-related information, and record jackpot related information whenever a jackpot over a threshold amount is won. In this manner, the claimed invention facilitates substantially uninterrupted gaming because it records the required jackpot information that is then later used to generate a statement (including, but not limited to an IRS statement) with the required player and jackpot information, *after* the gaming session has been completed.

The Bell, Bergeron, and Pease patents do not teach or suggest each and every element of the claimed invention. Indeed the Bell patent, while dealing with related issues, discloses a system that is directly at odds with the claimed invention, and thus, actually teaches away from the claimed invention. Accordingly, Applicant respectfully submits that the 35 U.S.C. § 103(a) rejection of claim 3 as unpatentable has been overcome.

7. Claims Rejections - 35 U.S.C. §103(a) – Claims 20, 21, 26, 34, 45, 46, and 48-50

Claims 20, 21, 26, 34, 45, 46, and 48-50 were rejected in the Office Action dated May 12, 2003, under 35 U.S.C. § 103(a) as being unpatentable in view of Acres (U.S. Patent No. 6,312,333), and further in view of Bergeron et al. (U.S. Patent No. 4,882,473) and Pease et al. (U.S. Patent No. 5,326,104). Applicants respectfully traverse this rejection. However, in order to provide clarification only, claims 20, 21, 26, 34, 45, and 46 have been amended. Claims 48-50 have been canceled. Claims 11, 23, 24, 29, and 36 are independent claims. Claims 20 and 21 depend from independent claim 11; claim 26 depends from independent claim 24; claim 34 depends from independent claim 29; and claims 45 and 46 depend from independent claim 36. For brevity, only the bases for the rejection of the independent claims are traversed in detail on the understanding that dependent claims are also patentably distinct over the prior art as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate, and independent bases for patentability.

The Examiner states that the Acres patent teaches the invention substantially as claimed, but does not teach inserting an agent card or selecting uninterrupted play from a menu. The Examiner further states that Bergeron teaches insertion of an agent card for the purpose of enhancing security, and that Pease teaches a menu-driven system. The shortcomings of the Acres patent are well documented in Section 5 above. Neither the Bergeron patent nor the Pease patent satisfy these shortcomings.

The Acres patent discloses a gaming machine that intentionally locks-up if a payout is won over a pre-established threshold, and then actually reduces the amount of the payout over the threshold. The Acres patent intentionally interrupts the gaming session, which is exactly what the claimed invention prevents. The Acres gaming machine then reduces the accumulated winnings of the player over the threshold amount. This is an action that many patrons may find highly objectionable and annoying.

In contrast, the claimed invention discloses a tracking device with a central server (not a gaming machine) that facilitates substantially uninterrupted gaming. The tracking device is configured to communicate with one or more gaming machines, store player-related information, and record jackpot related information whenever a jackpot over a threshold amount is won. In this manner, the claimed invention facilitates substantially uninterrupted gaming because it records the required jackpot information that is then later used to generate a statement (including, but not limited to an IRS statement) with the required player and jackpot information, *after* the gaming session has been completed.

In conclusion, the Acres, Bergeron, and Pease patents do not teach or suggest each and every element of the claimed invention. The Acres patent discloses a system that is directly at odds with the claimed invention, and accordingly, actually teaches away from the claimed invention. Accordingly, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejection of claims 20, 21, 26, 34, 45, and 46 as unpatentable has been overcome.

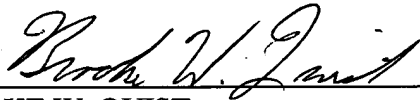
CONCLUSION

Applicant has made an earnest and bona fide effort to clarify the issues before the Examiner and to place this case in condition for allowance. In view of the foregoing discussions, it is clear that the differences between the claimed invention and the prior art are such that the claimed invention is patentably distinct over the prior art. Therefore, reconsideration and allowance of claims 1-47 is believed to be in order, and an early Notice of Allowance to this effect is respectfully requested. If the Examiner should have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 712-8319. The undersigned attorney can normally be reached Monday through Friday from about 9:30 AM to 6:30 PM Pacific Time.

Respectfully submitted,

Dated: _____

11/12/03



BROOKE W. QUIST
Reg. No. 45,030
BROWN RAYSMAN MILLSTEIN FELDER
& STEINER LLP
1880 Century Park East, Suite 711
Los Angeles, California 90067
(310) 712-8300

BWQ:elm